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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,519	06/05/2002	Burthus Lang	TRG-299	5973
7590 02/10/2006 LORUSSO, LOUD & KELLY LLP 15 RYE STREET, SUITE 312 PORTSMOUTH, NH 03801			EXAMINER BOCKELMAN, MARK	
			ART UNIT 3766	PAPER NUMBER
DATE MAILED: 02/10/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/030,519	LANG ET AL.	
	Examiner	Art Unit	
	Mark W. Bockelman	3766	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11-21-2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 24, the claim ends with “, as viewed in plan”.

Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim(s) fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the reply filed 11-21-2005. In that paper, applicant has stated the phrase “as viewed in plan” should mean “when looking at the electrode from a top view”, and this statement indicates that the invention is different from what is defined in the claim(s) because the language is different in scope and it is unclear which is a “top view”.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16-28,30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Canadian patent 1,219,642.

Canadian patent 1,218,642 shows several embodiments of electrode configurations. In figure 3, 3 potential electrode elements 30, 33, 36 are shown that extend to a tab 32 with three uncontacted elements. The elements are each capable of being contactable by an electrode or can be consider “free” of a contacting element depending upon the intended use. Applicant’s circular rings as shown in their drawings are all capable of being contacted by an electrical energy applicator. Thus, the examiner designates which elements are contactable in terms of intended use in interpreting applicant’s claims. In claims 16-21, 23-28, 30 and 32 the examiner considers the contactable conductor to be electrode 30 and the uncontacted conductor to either elements 33 and/or 36. Regarding claims 22, the examiner considers the inner uncontacted conductor 33 to extend into the space between contactable conductors 30 and 36. Regarding claim 31, the examiner considers the conductors to be formed in alternative (interleaved) surfaces (figure 4) wherein starting with the most inner conductor, every other conductor is contactable and the others are uncontacted.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 29 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Canadian patent 1,219,642. It is unclear as to which figure, if any, applicant has drafted claim 29 to cover. It appears that applicant considers two radially spaced contactable electrodes to have "substantially equal" surface areas and peripheral lengths. Since radially spaced electrodes would have both their peripheral lengths and surface areas vary as a function of the radius, it would appear that "substantially equal" has a fair degree of latitude. In this respect, the examiner considers the hook configurations of the various conductors in figure 4 of the Canadian reference to have "substantially equal" surface areas and peripheral lengths, and or it would have been obvious to modify the thicknesses of the electrodes to within such a range as an obvious design choice.

Response to Arguments

Applicant's arguments filed 11-21-2005 have been fully considered but they are not persuasive. Applicant wishes for the examiner to give intended use weight. The examiner considers the Canadian patent to teach each and every element except applicant's "negative" intended use of not using the outer metal ring for and electrode whereby the outer ring is not intended to be connected to a terminal. The examiner gives no patentable weight to this purely functional limitation. To the extent applicant's figures show "substantially equal", the examiner maintains so does the Canadian

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patent. The examiner understands what equal means, but does not have any guidelines for "substantially equal". The outer rings of the Canadian patent would not vary substantially in surface area from the inner in the examiner's eyes

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark W. Bockelman whose telephone number is (571) 272-4941. The examiner can normally be reached on Monday - Friday 10:00 to 6:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272 -6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MWB

February 6, 2006



MARK BOCKELMAN
PRIMARY EXAMINER